

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Alain LEAS et al.

Confirmation No.: 4476

Application No.: 10/797,373

Group Art Unit: 1761

Filing Date: March 9, 2004

Examiner: Viren A. Thakur

For: PACKAGED DECORATED FROZEN
CONFECTION AND METHOD OF
MANUFACTURE

Attorney Docket No.: 88265-74701

BRIEF ON APPEAL

Mail Stop: Appeal Brief - Patents

Commissioner for Patents

P.O. Box 1450

Alexandria, Virginia 22313-1450

Sir:

Appellants appeal to the Board of Patent Appeals and Interferences (the "Board") from the decision of the Examiner mailed November 26, 2008, rejecting claims 1-4, 8-10 and 25-37. This Appeal Brief is submitted in full compliance with the rules.

1. REAL PARTY IN INTEREST

The real party in interest is Nestec, S.A. ("Nestec"), having a business address of Avenue Nestlé 55, 1800 Vevey, Switzerland, the assignee of the entire right, title, and interest in the invention described and claimed in the above-identified patent application. The invention was assigned by Alain Leas, Jonathan Mastny, Adrianus Kruik, Robert Mazurek and Shirdan Grykiewicz to Nestec. The assignment was recorded on June 3, 2004 at reel 014687, frame 0086.

2. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences regarding the subject matter of this application.

3. STATUS OF CLAIMS

Claims 1-24 were submitted upon filing of this application, U.S. Patent Application No. 10/797,373 on March 9, 2004. In a response to a Restriction Requirement dated September 14, 2005, claims 1-10 were elected to be prosecuted, claims 11-24 were cancelled, and new claims 25-33 were added to cover preferred embodiments of the selected invention. In a non-final Office Action dated December 7, 2005, claims 1-10 and 25-33 were rejected. Claim 31 was rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. Claims 1-4, 8-10, 25, 26, 28, 30 and 32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 623,324 to Luigi Grigoli et al. ("Grigoli") in view of European Patent No. 0848910 to Kuehl et al. ("Kuehl"). Claims 5-7, 29 and 33 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Grigoli and Kuehl, and further in view of European Patent No. 276333 to D'Amato ("D'Amato"). Claim 27 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Grigoli in view of Kuehl, and further in view of Japanese Patent No. 2000-118590 to Tanaka et al. ("Tanaka"). Claim 31 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Grigoli and Kuehl, and further in view of U.S. Patent No. 5,425,527 to Selbak ("Selbak"). Claims 1-4, 8-10, 25-28, 30 and 32 were provisionally rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 6, 16, 17 and 20 of co-pending Application No. 10/294,764 in view of Kuehl. Claims 5-7, 29 and 33 were provisionally rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 6, 16, 17 and 20 of co-pending Application No. 10/294,764 in view of Kuehl, and further in view of D'Amato. Claim 31 was provisionally rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 6, 16, 17 and 20 of co-pending Application No. 10/294,764 in view of Kuehl, and further in view of Selbak. Claims 1-10 and 25-33 were provisionally rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9 and 19-33 of co-pending Application No. 10/385,177 in view of Kuehl. Claims 1-10 and 25-31 were provisionally rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 and 10-14 of co-pending Application No. 10/800,222 in view of Kuehl. Claims 32 and 33 were provisionally rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 and 10-14 of co-pending Application No. 10/800,222 in view of Kuehl, and further in view of D'Amato.

Claims 1-10 and 25-31 were provisionally rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3 and 7-14 of co-pending Application No. 10/984,914 in view of Kuehl. Claims 32 and 33 were provisionally rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3 and 7-14 of co-pending Application No. 10/984,914 in view of Kuehl, and further in view of D'Amato.

In a Response filed April 7, 2006, Appellants amended claims 1, 2, 5, 7 and 29.

In a final Office Action dated June 19, 2006, the Examiner withdrew the rejection of claim 31 under 35 U.S.C. § 112, first paragraph. Claims 1-4, 8-10, 25, 26, 28, 30 and 32 remained rejected under 35 U.S.C. § 103(a) as being unpatentable over Grigoli in view of Kuehl. Claims 5-7, 29 and 33 remained rejected under 35 U.S.C. § 103(a) as being unpatentable over Grigoli and Kuehl, and further in view of D'Amato. Claim 27 remained rejected under 35 U.S.C. § 103(a) as being unpatentable over Grigoli and Kuehl, and further in view of Tanaka. Claim 31 remained rejected under 35 U.S.C. § 103(a) as being unpatentable over Grigoli and Kuehl, and further in view of Selbak. Claims 1-4, 8-10, 25-28, 30 and 32 remained provisionally rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 6, 16, 17 and 20 of co-pending Application No. 10/294,764 in view of Kuehl. Claims 5-7, 29, and 33 remained provisionally rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 6, 16, 17, and 20 of co-pending Application No. 10/294,764 in view of Kuehl further in view of D'Amato. Claim 31 remained provisionally rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 6, 16, 17, and 20 of co-pending Application No. 10/294,764 in view of Kuehl further in view of Selbak. Claims 1-10 and 25-33 remained provisionally rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9 and 19-33 of co-pending Application No. 10/385,177 in view of Kuehl. Claims 1-10 and 25-31 remained provisionally rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 and 10-14 of co-pending Application No. 10/800,222 in view of Kuehl. Claims 32 and 33 remained provisionally rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 and 10-14 of co-pending Application No. 10/800,222 in view of Kuehl further in view of D'Amato. Claims 1-10 and 25-31 remained provisionally rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3 and 7-14

of co-pending Application No. 10/984,914 in view of Kuehl. Claims 32 and 33 remained provisionally rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3 and 7-14 of co-pending Application No. 10/984,914 in view of Kuehl further in view of D'Amato.

In an interview dated August 15, 2006, the Examiner and Appellants discussed the pending claims and the cited references. The interview resulted in Appellants amending the claims to include the pattern and transparent sleeve in order to overcome the cited art.

In a Response After Final Rejection dated August 21, 2006, Appellants amended claim 1 and cancelled claims 5-7.

An Advisory Action was mailed on October 20, 2006, indicating that the August 21, 2006 Response by Appellants was entered but failed to place the application in condition for allowance.

In a Request for Continued Prosecution dated December 15, 2006, Appellants amended claim 1.

In an Office Action dated January 29, 2007, the rejection of claims 1-4, 8-10, 25, 26, 28, 30 and 32 under 35 U.S.C. § 103(a) as being unpatentable over Grigoli in view of Kuehl was withdrawn. Claim 1 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter of the instant invention. Claims 1-4, 8-10, 25, 26, 29-30, 32 and 33 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Grigoli and Kuehl further in view of D'Amato. Claim 27 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Grigoli, Kuehl and D'Amato, and further in view of Tanaka. Claim 31 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Grigoli, Kuehl and D'Amato, and further in view of Selbak. Claims 1-4, 8-10, 25-30, 32, and 33 remained provisionally rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 6, 16, 17 and 20 of co-pending Application No. 10/294,764 in view of Kuehl, and further in view of D'Amato. Claim 31 remained provisionally rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 6, 16, 17, and 20 of co-pending Application No. 10/294,764 in view of Kuehl and D'Amato, and further in view of Selbak. Claims 1-8 and 25-33 remained provisionally rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9 and 19-33 of co-pending Application No. 10/385,177 in view of Kuehl. Claims

1-4, 8-10, and 25-31 remained provisionally rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 and 10-14 of co-pending Application No. 10/800,222 in view of Kuehl. Claims 32 and 33 remained provisionally rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 and 10-14 of co-pending Application No. 10/800,222 in view of Kuehl, and further in view of D'Amato. Claims 1-4, 8-10 and 25-31 remained provisionally rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3 and 7-14 of co-pending Application No. 10/984,914 in view of Kuehl. Claims 32 and 33 remained provisionally rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3 and 7-14 of co-pending Application No. 10/984,914 in view of Kuehl, and further in view of D'Amato.

In an Interview dated April 18, 2007, Appellants agreed to amend the limitation "all or part" in order to overcome the rejection over Grigoli. Further, the Examiner and Appellants discussed the motivation for transparent packaging and the potential continued applicability of U.S. Patent No. 2,106,893 to Krein ("Krein").

In a Response filed July 3, 2007 Appellants amended claims 1, 25, and 29, and added new claims 34-37. Appellants also submitted a Declaration of Alain Leas under 37 C.F.R. § 1.132 ("Leas Declaration") in support of patentability of the claims.

In a non-final Office Action dated September 25, 2007, the rejection of claim 1 under 35 U.S.C. § 112 was withdrawn. The 35 U.S.C. § 103(a) rejection of claims 1-4, 8-10, 25, 26, 29, 30 and 33 over Grigoli, Kuehl and D'Amato was also withdrawn. The 35 U.S.C. § 103(a) rejection of claim 27 over Grigoli, Kuehl, D'Amato and Tanaka was also withdrawn. Further, the 35 U.S.C. § 103(a) rejection of claim 31 over Grigoli, Kuehl, D'Amato and Selbak was also withdrawn. Claims 1-4, 8-10, and 25-37 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter of the instant invention. Claims 1-4, 8-10, and 25-37 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Krein in view of D'Amato and Kuehl. Claims 1-4, 8-10, 25-30, 32 and 33 and new claims 34-36 remained provisionally rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 6, 16, 17, and 20 of co-pending Application No. 10/294,764 in view of Kuehl, and further in view of D'Amato. Claim 31 remained provisionally rejected on the grounds of nonstatutory obviousness-type

double patenting as being unpatentable over claims 1-3, 6, 16, 17, and 20 of co-pending Application No. 10/294,764 in view of Kuehl and D'Amato further in view of Selbak. Claims 1-4, 8-10, and 25-33 remained provisionally rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9 and 19-33 of co-pending Application No. 10/385,177 in view of Kuehl. Claims 1-4, 8-10 and 25-31 remained provisionally rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 and 10-14 of co-pending Application No. 10/800,222 in view of Kuehl. Claims 32 and 33 remained provisionally rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 and 10-14 of co-pending Application No. 10/800,222 in view of Kuehl further in view of D'Amato. Claims 1-4, 8-10, and 25-31 remained provisionally rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3 and 7-14 of co-pending Application No. 10/984,914 in view of Kuehl. Claims 32 and 33 remained provisionally rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3 and 7-14 of co-pending Application No. 10/984,914 in view of Kuehl further in view of D'Amato.

In a Response filed January 22, 2008, Appellants amended claims 1, 9, 25, 29, 34, and 36.

In a final Office Action dated April 29, 2008 the rejection of claims 1-4, 8-10, and 25-37 under 35 U.S.C. § 112, second paragraph was withdrawn. The obviousness-type double patenting rejection of claims 30-32 over claims 1-3 and 7-14 of co-pending Application No. 10/984,914 was withdrawn. Claims 1-4, 8-10, 25-28 and 30-33 remained rejected under 35 U.S.C. § 103(a) as being unpatentable over Krein in view of D'Amato and Kuehl. Claims 9, 29, and 34-37 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Krein, D'Amato, and Kuehl, and in view of U.S. Patent No. 4,778,683 to Newsteder ("Newsteder"), U.S. Patent Publication No. 2003/0099746 A1 to Palmer ("Palmer") and U.S. Patent No. 5,035,907 to Philips et al. ("Philips"). Claims 1-4, 8-10, 25-30, 32, and 33 and new claims 34-36 remained provisionally rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 6, 16, 17, and 20 of co-pending Application No. 10/294,764 in view of Kuehl, and further in view of D'Amato. Claim 31 remained provisionally rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 6, 16, 17, and 20 of co-pending Application No. 10/294,764 in view of Kuehl and D'Amato,

and further in view of Selbak. Claims 1-4, 8-10, and 25-33 remained provisionally rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9 and 19-33 of co-pending Application No. 10/385,177 in view of Kuehl. Claims 1-4, 8-10, and 25-31 remained provisionally rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 and 10-14 of co-pending Application No. 10/800,222 in view of Kuehl. Claims 32 and 33 remained provisionally rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 and 10-14 of co-pending Application No. 10/800,222 in view of Kuehl, and further in view of D'Amato.

In a Response After Final Rejection dated October 21, 2008, Appellants presented arguments against the outstanding rejections of claims 1-4, 8-10, and 25-37.

Appellants filed a Notice of Appeal and a Pre-Brief Appeal Conference on October 28, 2008, presenting arguments in support of patentability of claims 1-4, 8-10 and 25-37, and against the rejections raised in the April 29, 2008 final Office Action.

An Advisory Action was mailed on November 10, 2008, indicating that the October 21, 2008 Response by Appellants failed to place the application in condition for allowance.

On November 26, 2008, a Notice of Panel Decision from Pre-Appeal Brief Review issued, indicating that claims 1-4, 8-10 and 25-37 remain rejected and that the present application remained under appeal.

The claims appealed, claims 1-4, 8-10 and 25-37, are presented in Appendix A. The claim listing in Appendix A provides the status of each claim as having been rejected or cancelled.

4. STATUS OF AMENDMENTS

Claims 1-4, 8-10, and 25-37 are presently pending, claims 5-7 and 11-24 have been cancelled, and claims 1, 2, 5, 7, 25, 29, 34, and 36 have been amended.

In an Amendment dated October 21, 2005, claims 11-24 were cancelled, and new claims 25-33 were added.

In a Response filed April 7, 2006 Appellants amended claims 1, 2, 5, 7 and 29.

In an Amendment After Final Rejection dated August 21, 2006, Appellants amended claim 1 and cancelled claims 5-7. This Amendment was entered by the Examiner.

In a Request for Continued Examination dated December 15, 2006, Appellants amended claim 1.

In a Response filed July 3, 2007, Appellants amended claims 1, 25, and 29, and added new claims 34-37. With this submission, Appellants also submitted the Declaration of Alain Leas dated July 2, 2007, under 37 C.F.R. § 1.132 in support of Appellants' position.

In a Response filed January 22, 2008, Appellants amended claims 1, 25, 29, 34, and 36.

A Notice of Appeal and Pre-Brief Appeal Conference was filed on October 28, 2008.

No claim amendments were filed subsequent to the April 29, 2008 final Office Action.

5. SUMMARY OF CLAIMED SUBJECT MATTER

The present invention generally relates to a packaged decorated composite frozen confection that includes an open-ended shell made of a solid, fat-based composition and having a shell wall that defines an interior volume for holding at least a portion of the ice confection. The composite frozen confection has a smooth outer surface on the shell wall, a decorative pattern forming a portion of the smooth surface outer wall, a packaging sleeve for protecting all or part of the outer surface of the shell, and a filling of a frozen confection at least in the interior volume of the shell.

In the art of frozen confection manufacture, efforts have been made to prepare ice cream cones with decorative toppings including the simulation of flowers or by pouring ingredients such as chocolate chips, dried fruit, nuts or sweets onto the ice cream topping. However, there remains a need for frozen confection cones having novel appearances for increasing consumer appeal for such products.

The present invention is a significant improvement over known composite frozen confection products by the creation of a decorative pattern onto the sidewall outer surface of a cone shaped shell. The decorative pattern is visible on the shell and may be an image, a message or other visual appearance that is different from that of the shell. This pattern is not only visible on the cone but the cone is placed in a plastic shell so that it will be visible in the packaged product as well.

Claim 1 defines a packaged decorated composite frozen confection product having an open-ended shell made of a solid, fat-based composition and having a shell wall that defines an interior volume for holding at least a portion of an ice confection. (U.S. Patent Application

Publication, p.1, para. [0007]; *see* Fig. 1). The shell wall has a substantially smooth outer surface, a decorative pattern design comprising strings of a first semi-solid confection material that form a mesh of strings and a second confection material of a contrasting color to that of the first confection material located between the strings. (*Id.* at p.1, [0006]-[0008] and [0016]; *see* Figs. 1, 2 and 4). The packaging sleeve protects all of the outer surface of the shell and is formed in a shape that corresponds to the shape of the outer surface of the shell and has an inner surface that is in contact with the outer surface of the shell to form and display the decorative pattern of the shell. (*Id.* at p.1, [0007]). The shell is filled with a frozen confection. (*Id.*). The confection product packaging sleeve is transparent and the entire outer surface of the shell is in complete surface-to-surface contact with the packaging sleeve. (*Id.* at p. 1, [0006]-[0008] and [0016]; *see e.g.*, Fig. 1).

Claims 2-4, 8-10 and 28-33 all depend directly or indirectly from claim 1, and further define features of the packaged decorated composite frozen confection product. Specifically, claim 2 recites that the strings which comprise the decorative pattern of the shell wall are flattened or pressed against the sleeve to assist in forming the smooth surface outer wall of the shell. (*Id.* at p. 1, [0013]-[0018]; p. 4, [0067]-[0070]; *see* Fig. 6). Claim 3 specifies that the shell has a consistent and even wall thickness and that the outside surface is shiny. (*Id.* at p. 1, [0008]; p. 3, [0058], [0063] - p.4, [0065]; *see* Figs. 2-4). Claim 4 recites that after removal of the packaging sleeve, the shell may be handled with the frozen filling at least initially maintaining the fat-based composition in solid form with good definition of the patterned design. (*Id.* at p.1, [0008]). Claims 5-7 were cancelled.

Claim 8 defines the shell's fat based composition as comprising chocolate. (*Id.* at p. 1, [0009]; p. 2, [0045]). Claim 9 further defines the decorative pattern design on the shell as including a writing, script, a logo or a symbol. (*Id.* at p. 1, [0009]; p. 2, [0046]; *see* Fig. 3). Claim 10 recites that the frozen confection comprises ice cream or a sorbet and that the pattern is a fat of contrasting color to the fat-based composition of the shell. (*Id.* at p. 2, [0047]; p. 3, [0050]). Claims 11-24 were cancelled. Claims 25, and dependent claims 26-27 are described further below.

Claim 28 recites that the strings used in the decorative frozen confection product are made of a fat-based material or fat-based ink, which may contain artificial colors, colored powders, or dyes that are fat soluble or fat dispersible. (*Id.* at p.3, [0049]-[0050]). Claim 29

further defines the pattern on the confection product as including a writing, script, a logo or a symbol, and defines the packaging sleeve as being made of a food grade flexible, clear plastic foil having a smooth surface in contact with the shell to provide the smooth outer surface on the shell, and to fully show the pattern through the packaging sleeve. (*Id.* at p. 2, [0046], [0048]; p. 3, [0053]; *see* Fig. 3). Claim 30 recites that the frozen confection that constitutes the filling or center of the shell volume is an ice cream or sorbet which is optionally aerated to provide a similar texture to that of an ice cream. (*Id.* at p. 2, [0047]). Claim 31 further defines the shell as comprising inclusions in the form of nuts, chocolate chips, sugar confectionery particles, preserved fruit, mint chips, or biscuit crumbles. (*Id.*). Claim 32 further defines the packaging sleeve as being configured to be longer than the height of the shell and frozen confection, and that the package may additionally contain a lid, which optionally may be transparent. (*Id.* at p. 3, [0060]). Claim 33 recites that the sleeve may comprise printed material in the form of stickers or other packaging adornments that are present on the sleeve or lid. (*Id.*).

Claim 25 defines a packaged decorated composite frozen confection product having an open-ended shell in the shape of a cylinder, polygon or cone, and made of a solid, fat-based composition. (*Id.* at p.2, [0044]). The shell wall defines an interior volume for holding at least a portion of an ice confection. (*Id.* at p.1, [0007]). The shell wall further has a substantially smooth outer surface, a decorative pattern design comprising strings of a first semi-solid confection material that form a mesh of strings and a second confection material of contrasting color to that of the first confection material is located between the strings. (*Id.* at p.1, [0006]-[0008] and [0016]; *see* Figs. 1, 2 and 4). The packaging sleeve protects all of the outer surface of the shell and is formed in a shape that corresponds to the shape of the outer surface of the shell, and has an inner surface that is in contact with the outer surface of the shell to form and display the decorative pattern of the shell. (*Id.* at p.1, [0007]). The shell is filled with a frozen confection. (*Id.*). The packaging sleeve is transparent, and the entire outer surface of the shell is in complete surface-to-surface contact with the packaging sleeve. (*Id.* at p. 1, [0006]-[0008] and [0016]; *see e.g.*, Fig. 1).

Claims 26 and 27 further define features of the packaged frozen confection product of claim 25. Specifically, claim 26 recites that portions of the cone have different circumferences (*Id.* at p.2, [0044]). Claim 27 recites that the frozen confection extends above the top of the shell so that the frozen confection can be consumed before the shell. (*Id.*; *see* Figs. 2-4).

Claim 34 defines a packaged decorated composite frozen confection product having an open-ended shell having the shape of a true or truncated cylinder, polygon, or cone made of a solid, fat-based composition. (*Id.* at p.2, [0044]). The shell wall defines an interior volume for holding at least a portion of an ice confection. (*Id.*) The shell wall has a substantially smooth outer surface, a decorative pattern design comprising strings of a first semi-solid confection material that form a mesh of strings and a second confection material of a contrasting color to that of the first confection material located between the strings, the strings forming a writing, script, a logo or a symbol. (*Id.* at p.1, [0013]-[0018]; p.2, [0046]; *see* Figs. 1-4). The packaging sleeve protects all of the outer surface of the shell and is formed in a shape that corresponds to the shape of the outer surface of the shell, and has an inner surface that is in contact with the outer surface of the shell to form and display the decorative pattern of the shell. (*Id.* at p.1, [0007]). The shell is filled with a frozen confection. (*Id.*). The product packaging sleeve is transparent, and the entire outer surface of the shell is in complete surface-to-surface contact with the packaging sleeve. (*Id.* at p. 1, [0006]-[0008] and [0016]; *see e.g.*, Fig. 1).

Claims 35-37 further define features of the packaged decorated frozen confection product defined in claim 34. Specifically, claim 35 recites that the fat-based composition of the shell comprises chocolate. (*Id.* at p. 1, [0009]; p. 2, [0045]). Claim 36 further defines the decorative pattern design on the fat-based shell of claim 34 as including a writing or script. (*Id.* at p.1, [0009]; p.2, [0046]; *see* Fig. 3). Claim 37 further defines the composite frozen confectionary product of claim 34 as comprising ice cream or a sorbet and as having a decorative pattern that is a fat of a contrasting color to that of the fat-based shell. (*Id.* at p. 2, [0047]; p. 3, [0050]).

6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

As explained above, it is believed that the only remaining rejections are as follows:

claims 1-4, 8, 10, 25-28, and 30-33 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Krein in view of D'Amato and Kuehl,

claims 9, 29 and 34-37 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Krein in view of D'Amato and Kuehl, and further in view of Newsteder, Palmer and Phillips,

claims 1-4, 8-10, 25-30, 32-36 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 6, 16, 17 and 20 of co-pending Application No. 10/294,764 in view of Kuehl and D'Amato,

claim 31 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 6, 16, 17 and 20 of co-pending Application No. 10/294,764 in view of Kuehl and D'Amato and further in view of Selbak,

claims 1-4, 8-10, 25-33 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9 and 19-27 of co-pending Application No. 10/385,177 in view of Kuehl,

claims 1-4, 8-10, 25-31 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 and 10-14 of co-pending Application No. 10/800,222 in view of Kuehl, and

claims 32 and 33 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 and 10-14 of co-pending Application No. 10/800,222 in view of Kuehl and D'Amato.

7. ARGUMENT

A. Non-Statutory Obviousness-Type Double Patenting Rejections

I. Provisional Rejection of Claims 1-4, 8-10, 25-30, 32-36

Claims 1-4, 8-10, 25-30 and 32-36 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 6, 16, 17 and 20 of co-pending Application No. 10/294,764 in view of Kuehl and D'Amato. Appellants note that as co-pending Application No. 10/294,764 has not been allowed, the provision has not occurred and accordingly this rejection should be reversed or at least deferred until a later time. If the co-pending application is allowed prior to this application, Appellants agree to submit an appropriate terminal disclaimer to overcome the obviousness-type double patenting rejection.

II. Provisional Rejection of Claim 31

Claim 31 was provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 6, 16, 17 and 20 of co-pending Application No. 10/294,764 in view of Kuehl and D'Amato and further in view of Selbak. Appellants note, as above, that as co-pending Application No. 10/294,764 has not been allowed,

the provision has not occurred and accordingly this rejection should be reversed or at least deferred until a later time. If the co-pending application is allowed prior to this application, Appellants agree to submit an appropriate terminal disclaimer to overcome the obviousness-type double patenting rejection.

III. Provisional Rejection of Claims 1-4, 8-10 and 25-33

Claims 1-4, 8-10 and 25-33 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9 and 19-27 of co-pending Application No. 10/385,177 in view of Kuehl. Appellants note that as co-pending Application No. 10/385,177 has not been allowed, the provision has not occurred and accordingly this rejection should be reversed or at least deferred until a later time. If the co-pending application is allowed prior to this application, Appellants agree to submit an appropriate terminal disclaimer to overcome the obviousness-type double patenting rejection.

IV. Provisional Rejection of Claims 1-4, 8-10, 25-31

Claims 1-4, 8-10 and 25-31 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 and 10-14 of co-pending Application No. 10/800,222 in view of Kuehl. Appellants note that as co-pending Application No. 10/800,222 has not been allowed, the provision has not occurred and accordingly this rejection should be reversed or at least deferred until a later time. If the co-pending application is allowed prior to this application, Appellants agree to submit an appropriate terminal disclaimer to overcome the obviousness-type double patenting rejection.

V. Provisional Rejection of Claims 32 and 33

Claims 32 and 33 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 and 10-14 of co-pending Application No. 10/800,222 in view of Kuehl and D'Amato. Appellants note, as above, that as co-pending Application No. 10/800,222 has not been allowed, the provision has not occurred and accordingly this rejection should be reversed or at least deferred until a later time. If the co-pending application is allowed prior to this application, Appellants agree to submit an appropriate terminal disclaimer to overcome the obviousness-type double patenting rejection.

B. Obviousness Rejections of Claims 1-4, 8-10 and 25-37 under 35 U.S.C. § 103(a)

I. Claims 1-4, 8, 10, 25-28 and 30-33 Were Improperly Rejected for Allegedly Being Obvious over the Combination of Krein, Kuehl and D'Amato

Claims 1-4, 8, 10, 25-28 and 30-33 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Krein in view of D'Amato and Kuehl. Specifically, the Examiner cites Krein as teaching an open-ended shell in surface-to-surface contact with a packaging sleeve, with a smooth outer surface.¹ The Examiner further relies on D'Amato to teach the conventionality of plastic transparent wrapping, and on Kuehl "to teach that it was conventional to employ a second edible material onto a first edible material for the purpose of making a particular design."² The Examiner's rejection of the pending claims based on the cited prior art references is in error because the presently disclosed invention is neither taught nor suggested in the disclosure in any of those references, or in any feasible combination thereof.

Specifically, the Examiner failed to establish proper bases for the obviousness rejections because there is: (1) no motivation to combine the references, and (2) no suggestion of the claimed invention in the references themselves. To establish an obviousness rejection, there must be a showing that there is a motivation to combine the prior art and that the combination of the prior art teaches or suggests each and every element of the claimed invention.³ Lack of motivation or suggestion demonstrates the patentability of the claims over the cited references.⁴ Without such motivation or suggestion, the rejection is improper and should be reversed for that reason alone.

The Examiner has also failed to consider each prior art reference for its teachings as a whole, including portions that would lead away from the claimed invention.⁵ Additionally, the

¹ See September 25, 2007 Office Action, pp. 3-4.

² See *id.* at pp. 5-6; see also November 10, 2008 Advisory Action, p.2, para. 6; see also April 29, 2008 Final Office Action, p.9.

³ *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002) (determining that the Board of Patent Appeals and Interferences improperly relied upon common knowledge and common sense of person of ordinary skill in art to find the invention obvious over combination of two prior art references, since factual question of motivation to select and combine references could not be resolved on subjective belief and unknown authority); *In re Bond*, 910 F.2d 831 (Fed. Cir. 1990) (finding a claimed invention not obvious when the teachings of the two prior art references provided no teaching, suggestion or incentive supporting the combination); *Elf Atochem North America, Inc. v. LaRoche Indus.*, 85 F. Supp.2d 336, 343 (D. Del. 2000) ("Two or more prior art references may be combined to demonstrate obviousness, but the prior art must provide a suggestion or motivation to combine the references"); see generally, Chisum, D. et al., *Principles of Patent Law*, Foundation Press, 1998, pp. 530-728.

⁴ *In re Lee*, 277 F.3d at 1338.

⁵ *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

Examiner has engaged in impermissible hindsight reasoning in arriving at the above-detailed obviousness rejections, because the cited references lack both express and inherent motivation for one skilled in the art to combine the references in the manner proposed, to result in the presently claimed invention.⁶

Applicants note that while it is well-established that no single reference needs to teach all of the elements claimed, there does need to be a suggestion of all the elements together in the claimed manner. Nevertheless, if references are to be combined, there needs to be a motivation found in the art to make the combination in the manner alleged. Neither the suggestion nor the motivation can be based on the teachings of appellants' disclosure.⁷ In the present instance, the Examiner has failed to cite a motivation to combine the above-mentioned references in a manner to teach that which is claimed. There is a clear lack of a motivation in the cited references for one skilled in the art to combine the references. The alleged nexus of similar ice confection products in the references is insufficient to render the present claims obvious, since each reference is not directed at applicants' invention but instead are directed at different features that are not relevant to the present claims. Furthermore, a skilled artisan having all of that prior art information before him or her is still not motivated to obtain the presently claimed invention, and the fact that none of the references even mention the possibility of forming products such as those that are presently claims support instead a finding that the claims are not obvious.

For the additional reasons presented below, Appellants respectfully request that the Examiner's obviousness rejections be reversed and that claims 1-4, 8, 10, 25-28 and 30-33 be allowed.

a. Krein

Krein relates to a method of making a frozen confection package wherein the ice confection is coated with chocolate and the entire product is housed in a temporary wrapper. Leas declaration, para. 11. Specifically, Krein discloses a method for coating a confection by spraying the coating material into a temporary wrapper, placing the confection within the lining, and allowing the confection to harden within the temporary wrapper. *Id.* Importantly, Krein uses a temporary, paper wrapper to enclose its product, which wrapper is strippable from the

⁶ *Id.*

⁷ *In re McLaughlin* 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971) ("Any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made and does not include knowledge gleaned only from applicant's disclosure, such a reconstruction is proper.")

confection, and contains overlapping, ungummed portions. *Id.* Accordingly, Krein's confection is only visible to the consumer upon stripping away the temporary wrapper. Krein expressly states that a "very highly desirable, if not essential," consideration in choosing material for the wrapper is that the wrapper be "of such economical material as to be destroyed and discarded at the time it is desired to eat the confection."⁸ It is apparent from Krein's disclosure, that Krein was primarily interested in providing an efficient and economic method of making a frozen confectionary product with a chocolate coating and a temporary wrapper.⁹ While Krein acknowledges the two-tone color effect of his confection that is produced after stripping the opaque wrapper, such visual effect is clearly incidental, as Krein is not interested in the actual appearance of his product, but rather in the economical production and packaging of cones. *See* Leas Declaration, para. 19.¹⁰ Further, Krein does not disclose a shell having a smooth outer surface. In stark contrast, the present invention discloses a shell with a smooth outer surface, wherein the shell is in complete surface-to-surface contact with a transparent packaging sleeve. Leas Declaration, para. 5. This enables the consumer to view the product and be incentivised to purchase it due to its interesting appearance. Krein's product and packaging provides no such viewing or incentive. This is because any decorative patterns on Krein's product is viewable by a consumer only after stripping the wrapper, and this is not done until after the product is purchased. Placing images or other indicia on the packaging in a conventional way also does not detract from applicants' invention because the actual product to be consumed is shown, and the consumer gets to see exactly what is being purchased for consumption.

b. D'Amato

D'Amato is directed to a cone-shaped plastic container for housing ice cream, and a lid made of the same material, that is fitted for closing the conical opening of the container. Leas Declaration, para. 8. Both container and lid consist of a liquid-tight, transparent material, such that the package housed therein is viewable by the consumer. Leas Declaration, para. 8. D'Amato also appears to teach advertising on the transparent material. *See* D'Amato Fig. 3.

⁸ *See* Krein, p. 1, lines 21-40.

⁹ *See also* Krein, p.1, lines 25-30 ("it has not as yet been possible to line a wrapper of paper, for example, with chocolate, and freeze a confection ... with sufficient facility and economy to warrant commercial production..."); Krein, p. 1, lines 21-23 (stating that in commercial manufacture of confections, "simplicity, ease of handling, and economy are very highly desirable, if not essential"); Krein p.1, lines 18-21 (stating that individual manufacture and production of confection packages is "so *expensive* (emphasis added) and laborious as not to be feasible, in most cases, for commercial manufacture").

¹⁰ *See also* supra nn. 8-9.

First of all, D'Amato's ice confection is prepared outside the packaging, and thereafter placed in the packaging, such that there can be no complete surface-to-surface contact between the ice confection and the packaging as recited in the present claims. D'Amato, Figs. 2 and 3; Leas Declaration, para. 8. There also would not be a smooth exterior surface of the shell, since there is no disclosure in D'Amato as to how to form such a smooth surface cone. It is conventional known that most cone products are in fact not smooth. Furthermore, D'Amato's container is intended for holding and transporting prefabricated confections, while ensuring that the confections are cushioned and protected from damage during transportation. The plastic container also serves to prevent dirt and grime from coming in contact with the ice confection, and as a barrier between the consumer's hand and the ice confection, so as to prevent the confection from melting too quickly. *See* D'Amato, Col. 1, line 1-Col. 2, line 55. This of necessity requires some space between the packaging and the product to provide such cushioning. In contrast, this is not what is presently claimed, so that the combination of Amato and Krein does not result in the present invention.

The provision of the outer surface of the shell in contact with the sleeve provides unexpected results. As previously noted, this enables the consumer to view the product that they are intending to purchase and consume. And the smooth outer surface of the shell, while attractive in its own right, includes a decorative pattern design which forms part of the smooth outer surface of the shell, thus providing further attractiveness and desirability to the appearance of the product. This is because the pattern design comprises strings of a first semi-solid confection material that form a mesh of strings and a second confection material of a contrasting color to that of the first confection material located between the strings. The strings can be arranged to form patterns of shapes or words to provide unique appearances to the products, thus facilitating acceptance and sales by consumers. In contrast, D'Amato includes open space between his sleeve and product which diminished the impact of the appearance of the product. Furthermore, even when a plastic container is used, D'Amato preferably places his ice confections in cardboard sleeves which contains advertisements, labels or pictures, which may be viewable through the plastic container, relying upon the advertising, rather than the product itself, to encourage sales. *See* D'Amato Fig. 3. As the chocolate cone of the present invention is formed in the packaging sleeve with complete surface-to-surface contact between the cone and

the packaging sleeve, and with the cone having a smooth outer shell surface, its appearance is enhanced compared to D'Amato's products. Leas Declaration, paragraph 5.

c. Kuehl

Kuehl discloses a chocolate coating having a marbled appearance. Kuehl is concerned with ice cream bars coated with chocolate and having a marbled appearance, and not chocolate cone-shaped products as claimed in the present invention. *See* Kuehl, Examples 1-6, Leas Declaration, para. 7. The coating is prepared from a coating material, which may be chocolate, or a water-based material such as creamy mixes, non-aerated ice cream mixes, sorbets, water ices, or fruit purees. *See* Leas Declaration, para. 7. Kuehl teaches that coatings in which one layer consists of either milk or plain chocolate and the other layer consists of white chocolate are the most interesting visually because there may be a marked contrast between the milk or plain chocolate and the white chocolate. *Id.* Kuehl does not disclose a packaging sleeve for wrapping the bars, and either places strips of chocolate in a production mold, or applies chocolate strips or dots upon ice confections shaped as bars. *Id.* Neither of these embodiments relate to a chocolate shell in complete surface-to-surface contact with a transparent packaging sleeve. *Id.*

The maintenance of a smooth outer surface is not of significance or concern to Kuehl, who instead focuses on providing a visually interesting product having different colors or surface contours. Leas Declaration, paras. 7 and 15. Kuehl further does not utilize a sleeve that conforms to the outer surface of the confection. Leas Declaration, para. 15. Finally, Kuehl's confectionary product is prefabricated prior to being placed in its packaging. In contrast, the product of the present invention has a smooth outer surface and a sleeve which is formed in a shape that corresponds to the desired shape of the shell, and which is in complete surface-to-surface contact with the shell. Leas Declaration, paragraph 15. Even if Kuehl's disclosure is combined with that of Krein and D'Amato, therefore, a skilled artisan cannot obtain the presently claimed invention.

d. There is no Motivation to Combine the Teachings of Krein and D'Amato to Result in the Present Invention

Additionally, there is no motivation in Krein to combine the teachings therein with that of D'Amato, such that Krein's ice confection is enclosed in the transparent packaging sleeve of D'Amato. Simply because both Krein and D'Amato generally disclose ice confectionary products, does not mean that unrelated portions of the disclosures of each reference may be

combined with hindsight reconstruction, using Appellants' specification as a guide, to render the presently claimed invention obvious.¹¹ While Krein is concerned with providing an economical means for making a frozen confection, D'Amato focuses on providing a durable container in which ice confections may be transported and handled without damage. One of skill in the art would not be motivated to combine the divergent teachings of these two references, because the disclosures of the two references are unambiguously directed at solving very different problems. Further, portions of Krein clearly teach away from combination with D'Amato, as such combination would defeat the central purpose of Krein's invention.

While the Examiner notes that Krein "does not need to be relied on for addressing the problem of viewing the decoration on the food product"¹² the Examiner improperly concludes that Krein provides "motivation to the ordinarily skilled artisan since the ice cream has a pleasing two-tone appearance."¹³ Despite the unambiguous disclosure of Krein, and the specific citations provided by Appellants above, the Examiner insists that Krein "is concerned with the appearance of the ice cream since he teaches that as the wrapping is removed the consumer would see a two-tone and highly attractive color effect."¹⁴ Accordingly, the Examiner concludes that "Krein does provide motivation to the ordinarily skilled artisan since the ice cream has a pleasing ... appearance."¹⁵

However, as previously explained,¹⁶ Krein's mere recognition of the attractive appearance of his product, which is only viewable after the consumer has stripped away the wrapper, does not constitute motivation for a person of ordinary skill in the art to combine with D'Amato. Indeed, if the appearance of the confectionary product were truly of concern to Krein, he would have chosen a transparent packaging material, such that the consumer could view the product therein, before stripping away the wrapper. Transparent packaging wrappers were known and available at the time of Krein's disclosure, but Krein chose to use an opaque paper wrapper, as Krein's concerns centered around feasibility of manufacture and ease of removal of

¹¹ *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984); *In re McLaughlin* 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971).

¹² See November 10, 2008 Advisory Action, p. 2, para. 1.

¹³ See November 10, 2008 Advisory Action, p. 2, para. 1.

¹⁴ See April 29, 2008 Office Action, p. 9.

¹⁵ See November 10, 2008 Advisory Action, p. 2, para. 1.

¹⁶ See Appellants' Jan. 22, 2008 Response, p. 9-10.

the wrapper.¹⁷ See Leas Declaration, para. 19. It is clear from Krein's disclosure and his choice of an opaque packaging material, that Krein's integral concern was to provide an economical wrapper, and not to allow the consumer to view the product through the wrapper. Accordingly, there would be no advantage in including a decorative pattern design on the shell of Krein, since the consumer would only see the wrapper, and not any pattern on the shell. See Leas Declaration, para. 19. Krein's mere acknowledgement of the visual appearance of his product, which would only be viewable upon removal of the packaging wrapper and immediately prior to consumption does not provide motivation for use of transparent packaging, as disclosed by D'Amato. And even where D'Amato uses a transparent container, he provides an opaque paper insert that includes advertising or other indicia thereon so that the consumer views the advertising rather than the product. This certainly does not demonstrate that D'Amato was concerned with providing the visibility of his products through the packaging. Thus, like Krein, this is not a concern of his disclosure and a skilled artisan would not be taught to do what applicants have done even with a full understanding of Krein and D'Amato.

The Examiner has failed to properly explain how Krein's choice to use opaque packaging for his cone (especially when transparent packaging options were available), may properly be reconciled with the Examiner's assertion that Krein provides motivation for allowing consumers to view the confectionary product through its packaging. Although Krein's product may exhibit a two-tone effect upon stripping away the wrapper,¹⁸ Krein does not provide motivation for employing transparent packaging, as set forth by the Examiner,¹⁹ in part because any modification of Krein's cone by adding D'Amato's more expensive packaging would defeat the central purpose of Krein's invention, which is to provide an economical packaging for housing a confection which is intended to be stripped away prior to consumption. This is especially true, as explained above, in light of the express disclosure in Krein, stating that a "very highly desirable, if not essential," consideration in choosing material for the wrapper is that the wrapper

¹⁷ In the Advisory Action issued November 10, 2008, the Examiner points out that the economical considerations affecting Krein as highlighted by Appellants (in Response to X...) "are based on the production capabilities at the time of Krein's invention (*i.e.* 1938) and not at the time of applicant's invention." Appellants note that the economic considerations previously highlighted are relevant and instructive in demonstrating the central purpose of Krein's invention, which was to provide an economical packaging for confectionary. Accordingly, the considerations appropriately taken into account would be those prevalent at the time of Krein's invention, and not at the time of Appellants' invention.

¹⁸ Krein, p.1, lines 46-53.

¹⁹ See *e.g.*, November 10, 2008 Advisory Action, p. 2, para. 4.

be “of such economical material as to be destroyed and discarded at the time it is desired to eat the confection.”²⁰ Both the Federal Circuit and the MPEP clearly explain that if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984).

In the November 10, 2008 Advisory Action, the Examiner points out that the economical considerations affecting Krein as highlighted by Appellants in Appellants’ January 22nd and October 21st Responses “are based on the production capabilities at the time of Krein’s invention (*i.e.* 1938) and not at the time of applicant’s invention.”²¹ Appellants note that the economic considerations previously highlighted and also as explained above, are relevant and instructive in demonstrating the central purpose of Krein’s invention, which was to provide an economical packaging for confectionary. Accordingly, the considerations appropriately taken into account would be those prevalent at the time of Krein’s invention, and not at the time of Appellants’ invention. Notably, the Examiner has failed as yet to provide an appropriate justification as to how Krein’s disclosure may be reconciled and combined with D’Amato, allowing for Krein’s cone to be wrapped in transparent packaging which is more expensive than paper, when Krein’s disclosure is replete with concerns regarding minimizing production costs.²²

Under the decision by the Court of Appeals for the Federal Circuit in *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727 (2007), there must be a reason for a person of ordinary skill in the art to combine the elements claimed in order for there to exist a finding of obviousness. As set forth above, there is no reason to combine the teachings of the references as suggested by the Examiner so that the obviousness rejection should be reversed.

Recent decisions by this Board are in accordance with the Court’s holding in the *KSR* decision. In view of the above, there is no evidence or suggestion in D’Amato to use a clear plastic sleeve that is in complete contact with the outer surface of a shell that includes a pattern of strings of contrasting color in the smooth outer surface of the shell, nor is there any evidence

²⁰ See Krein, p. 1, lines 21-40.

²¹ See Advisory Action, p.2, para.1.

²² For example, Krein states that “it has not as yet been possible to line a wrapper of paper, for example, with chocolate, and freeze a confection ... with sufficient facility and economy to warrant commercial production...” Krein, p. 1, lines 25-30. Krein also states that in commercial manufacture of confections, “simplicity, ease of handling, and economy are very highly desirable, if not essential.” Krein, p. 1, lines 21-23. Krein further states that individual manufacture and production of confection packages is “so *expensive* (emphasis added) and laborious as not to be feasible, in most cases, for commercial manufacture” Krein, p. 1, lines 18-21.

or suggestion in D'Amato to modify Krein for this purpose. See Ex Parte Katoh et al, Board Appeal Decision 20071460, Decided May 29, 2007. Furthermore, the Examiner has not provided any evidence that it was conventional in the art to provide such an arrangement. See Ex Parte Owlett, Board Appeal Decision 20070644, Decided June 20, 2007. Accordingly, the Examiner has not provided a sufficient reason or explicit analysis of why the disclosures of the references should be combined. See Ex Parte Erkey et al, Board Appeal Decision 20071375, Decided May 11, 2007. Applicants submit that there is no suggestion to combine the teachings and suggestions of Krein and D'Amato, as advanced by the Examiner, except by using Applicants' invention as a template through a hindsight reconstruction of Applicant's claims. See Ex Parte Crawford et al, Board Appeal Decision 20062429, Decided May 30, 2007.

For the reasons described above, Appellants submit that the combination of Krein and D'Amato is improper and insufficient in establishing a *prima facie* case of obviousness.

c. Kuehl may not Properly be Combined with the Teachings of Krein and D'Amato to Result in the Present Invention

The combination of Kuehl with Krein and D'Amato is also improper as there is no unifying motivation or theme amongst the three references, aside from the fact that they all relate to confectionary products. As explained above, Kuehl is primarily concerned with coating ice cream bars with an attractive visual appearances, and does not disclose or suggest fat-based shells, chocolate or otherwise. See Kuehl, Examples 1-6; Leas Declaration, para. 7. Further, maintenance of a smooth outer surface is not of concern to Kuehl, and is merely incidental to Kuehl's products. While Krein discloses a shell which is in complete surface-to-surface contact with its packaging, Kuehl does not as he utilizes a production mold for this purpose. Thus, there is no motivation to combine Krein and Kuehl for the reasons enumerated above, and further because Krein is not interested in the visual appearance of his product, rather focusing on an economical means of production thereof. Accordingly, there would be no advantage in including a decorative pattern design on the shell of Krein, since the consumer would only see the wrapper, and not any pattern on the shell. See Leas Declaration, para. 19. In fact, Krein teaches away from Kuehl by using an opaque packaging material to economically manufacture cones such that the confectionary product is only viewable after stripping away the packaging and prior to consumption. Kuehl further fails to disclose or suggest economical concerns for mass production of his ice cream bars, or the use of inexpensive materials. Additionally, there is no

disclosure or suggestion that Kuehl's method of creating attractive visual effects on ice cream bars would even be suitable for creating such effects on fat-based shells or wafer cones, as are disclosed in Krein and D'Amato. While Kuehl teaches that strips of coating material may be provided in a production mold for coating confectionary products, there is no disclosure or suggestion that the strips should be placed in the packaging material, or of a shell being formed within the packaging material itself,²³ such that it is in complete surface-to-surface contact with the packaging material. In fact, it would take significant redesign of Kuehl's equipment to result in the presently claimed patterns, which are formed within the packaging sleeve.

Accordingly, one of ordinary skill in the art would not be motivated to combine the teachings of Kuehl and Krein. One of ordinary skill in the art would further not be motivated to combine the teachings of Kuehl and D'Amato, as Kuehl does not disclose the benefits of, or the need for packaging that protects from damage during transportation or sale. Further, Kuehl is concerned with ice cream bars and not cones as disclosed in D'Amato. Indeed Kuehl's ice cream bars would have no need for D'Amato's cone-shaped container and lid. Accordingly, Appellants reiterate that obviousness rejections may not be made by hindsight reconstruction of the art, using Appellants' disclosure as a guide, which is the only way the Examiner could have arrived at the instant obviousness rejection.

As none of Krein, Kuehl or D'Amato teach or suggest a fat-based shell that has its entire surface in a pattern of at least two different colored confections and with a smooth outer surface in complete surface-to-surface contact with a packaging sleeve, as recited in independent claims 1, 25 and 34, these claims, and the claims dependent thereon, cannot be obvious over these references.

Accordingly, since the present invention is neither taught nor suggested in the disclosures of any of the above-mentioned references, or in any feasible combination thereof, the present claims are not rendered obvious by these references, and the obviousness rejection of these claims should be vacated.

²³ In the November 10, 2008 Advisory Action, the Examiner notes that this distinction is not persuasive, as "the [instant] claims do not recite this limitation and further since the claims are directed to a product and not the method by which the product is made." Appellants wish to clarify that this distinction is indeed relevant as it demonstrates that since Kuehl's product is prefabricated prior to being placed in its packaging, Kuehl's ice cream bars cannot be in complete surface-to-surface contact with the packaging, which is an essential feature of the instant product being claimed.

II. Claims 9, 29 and 34-37 Were Improperly Rejected for Allegedly Being Obvious over the Combination of Krein, Kuehl and D’Amato, and further in view of Newsteder, Palmer and Phillips

Claims 9, 29 and 34-37 remain rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Krein, D’Amato and Kuehl, and further in view of Newsteder, Palmer and Phillips. These claims contain an additional feature, specifying the types of decorative patterns, *i.e.*, writing, script, symbol or a logo, that may be formed on the outer shell, in a manner that is highly simplified over the art. Specifically, the Examiner argued that “Newsteder, Kuehl, and Palmer and Phillips have all been relied on to teach that it has been conventional in the art to employ a second edible material to impart a design.”²⁴ While the Examiner concedes that the combination of Krein, D’Amato and Kuehl does not teach or disclose a decorative pattern design including writing, script, a logo or a symbol,²⁵ the Examiner states that Newsteder, Palmer and Phillips demonstrate that it is well known in the art to use symbols, logo or writing to impart a design onto a food product.²⁶ Accordingly, the Examiner concludes that since Kuehl teaches decorative patterns, it would have been obvious to modify the pattern of Kuehl to display a message, symbol, writing or logo, thus rendering the invention disclosed in claims 9, 29 and 34-37 obvious. Appellants note that while Newsteder, Palmer and Phillips all disclose methods by which to impart design or lettering onto food, none of the references disclose or suggest that the methods disclosed therein would even be suitable for imparting design or lettering to shells used in ice confectionaries.

As the combination of Krein, Kuehl and D’Amato fails to disclose or suggest all the elements of independent claims 1, 25 and 34 of the presently claimed invention for the reasons described above, the addition of Newsteder, Palmer and Phillips does not remedy the deficiencies of Krein, Kuehl and D’Amato, in rendering dependent claims 9, 29 and 34-37 obvious over the prior art. Applicants have not invented patters but instead has applied them in a new an inventive way to enhance the appearance and sales of ice confection products. Accordingly, Appellants submit that the obviousness rejection of claims 9, 29 and 34-37 is in error and should be reversed.

²⁴ Nov. 10, 2008 Advisory Action, p.2, para. 6.

²⁵ Apr. 29, 2008 Final Office Action, p. 3, para. 5.

²⁶ *Id.*

8. CONCLUSION

Appellants respectfully submit that the Examiner's rejection of claims 1-4, 8-10, 25-37 is in error and warrants reversal by the Board so that the pending claims may be allowed.

Respectfully submitted,

1/13/09
Date


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APPENDIX A – CLAIMS APPENDIX

1. (Rejected) A packaged decorated composite frozen confection product comprising:

an open-ended shell made of a solid, fat-based composition and having a shell wall that defines an interior volume for holding at least a portion of an ice confection therein, the shell wall having a substantially smooth outer surface;

a decorative pattern design forming a smooth surface of the outer wall of the shell, said pattern design comprising strings of a first semi-solid confection material that form a mesh of strings and a second confection material of a contrasting color to that of the first confection material located between the strings;

a packaging sleeve for protecting all of the outer surface of the shell, with the packaging sleeve formed in a shape that corresponds to the desired shape of the outer surface of the shell and having an inner surface that is in contact with the outer surface of the shell to form and display the pattern; and

a filling of a frozen confection at least in the interior volume of the shell;

wherein the entire packaging sleeve is transparent, and the entire outer surface of the shell is in complete surface-to-surface contact with the packaging sleeve.

2. (Rejected) The decorated composite frozen confection product according to claim 1, wherein the strings are flattened or pressed against the sleeve to assist in forming the smooth surface outer wall of the shell.

3. (Rejected) The decorated composite frozen confection product according to claim 1, wherein the shell has a consistent and even wall thickness and the outside surface is shiny.

4. (Rejected) The decorated composite frozen confection product according to claim 1, wherein after removal of the packaging sleeve, the shell may be handled with the frozen filling at least initially maintaining the fat-based composition in solid form with good definition of the patterned design.

Claims 5 - 7. (Cancelled)

8. (Rejected) The decorated composite frozen confection product according to claim 1, wherein the fat-based composition comprises chocolate.

9. (Rejected) The decorated composite frozen confection product according to claim 1, wherein the decorative pattern design includes a writing, script, a logo or a symbol.

10. (Rejected) The decorated composite frozen confection product according to claim 1, wherein the frozen confection comprises ice cream or a sorbet and the pattern is a fat that has a color that contrasts with that of the fat-based composition of the shell.

Claims 11 - 24. (Cancelled)

25. (Rejected) A packaged decorated composite frozen confection product comprising:

- an open-ended shell having the shape of a true or truncated cylinder, polygon, or cone made of a solid, fat-based composition and having a shell wall that defines an interior volume for holding at least a portion of an ice confection therein, the shell wall having a substantially smooth outer surface;

- a decorative pattern design forming a smooth surface of the outer wall of the shell, said pattern design comprising strings of a first semi-solid confection material that form a mesh of strings and a second confection material of a contrasting color to that of the first confection material located between the strings;

- a packaging sleeve for protecting all of the outer surface of the shell, with the packaging sleeve formed in a shape that corresponds to the desired shape of the outer surface of the shell and having an inner surface that is in contact with the outer surface of the shell to form and display the pattern; and

- a filling of a frozen confection at least in the interior volume of the shell;

wherein the entire packaging sleeve is transparent, and the entire outer surface of the shell is in complete surface-to-surface contact with the packaging sleeve.

26. (Rejected) The decorated composite frozen confection product according to claim 25, wherein portions of the cone have different circumferences.

27. (Rejected) The decorated composite frozen confection product according to claim 25, wherein the frozen confection extends above the top of the shell so that the frozen confection can be consumed before the shell.

28. (Rejected) The decorated composite frozen confection product according to claim 1, wherein the strings are made of a fat-based material or a fat-based ink, optionally containing artificial colors, colored powders, or dyes that are fat soluble or fat dispersible.

29. (Rejected) The decorated composite frozen confection product according to claim 28, wherein the pattern includes a writing, script, a logo or a symbol, and the packaging sleeve is made of a food grade flexible, clear plastic foil having a smooth surface in contact with the shell to provide the smooth outer surface on the shell and to fully show the pattern through the packaging sleeve.

30. (Rejected) The decorated composite frozen confection product according to claim 1, wherein the frozen confection that constitutes the filling or center of the shell volume is an ice cream or sorbet, optionally aerated to provide a similar texture to that of an ice cream.

31. (Rejected) The decorated composite frozen confection product according to claim 1, wherein the shell further comprises inclusions in the form of nuts, chocolate chips, sugar confectionery particles, preserved fruit, mint chips, or biscuit crumbles.

32. (Rejected) The decorated composite frozen confection product according to claim 1, wherein the sleeve is configured to be longer than the height of the shell and frozen

confection, and the package is completed by the addition of a lid, which optionally may be transparent.

33. (Rejected) The decorated composite frozen confection product according to claim 32, which further comprises printed material in the form of stickers or other packaging adornments that are present on the sleeve or lid.

34. (Rejected) A packaged decorated composite frozen confection product consisting essentially of:

- an open-ended shell having the shape of a true or truncated cylinder, polygon, or cone made of a solid, fat-based composition and having a shell wall that defines an interior volume for holding at least a portion of an ice confection therein, the shell wall having a substantially smooth outer surface;

- a decorative pattern design forming a smooth surface of the outer wall of the shell, said pattern design comprising strings of a first semi-solid confection material that form a mesh of strings and a second confection material of a contrasting color to that of the first confection material located between the strings, the strings forming a writing, script, a logo or a symbol;

- a packaging sleeve for protecting all of the outer surface of the shell, with the packaging sleeve formed in a shape that corresponds to the desired shape of the outer surface of the shell and having an inner surface that is in contact with the outer surface of the shell to form and display the pattern; and

- a filling of a frozen confection at least in the interior volume of the shell;

wherein the entire packaging sleeve is transparent and the packaging sleeve is made of a food grade flexible, clear plastic foil having a smooth surface in contact with the shell to fully show the pattern through the packaging sleeve, and the entire outer surface of the shell is in complete surface-to-surface contact with the packaging sleeve.

35. (Rejected) The decorated composite frozen confection product according to claim 34, wherein the fat-based composition comprises chocolate.

36. (Rejected) The decorated composite frozen confection product according to claim 34, wherein the decorative pattern design includes a writing-or script.

37. (Rejected) The decorated composite frozen confection product according to claim 34, wherein the frozen confection comprises ice cream or a sorbet and the pattern is a fat that has a color that contrasts with that of the fat-based composition of the shell.

APPENDIX B – EVIDENCE APPENDIX

The Declaration of Alain Leas (“Leas Declaration”)

- **Signed on July 2, 2007; filed on July 3, 2007**
- **By Alain Leas**
- **Considered by Examiner in Sep. 25, 2007 non-final Office Action**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Alain LEAS et al.

Confirmation No.: 4476

Application No.: 10/797,373

Group Art Unit: 1761

Filing Date: March 9, 2004

Examiner: Viren A. Thakur

For: PACKAGED DECORATED FROZEN
CONFECTION AND METHOD OF
MANUFACTURE

Attorney Docket No.: 88265-74701

DECLARATION OF ALAIN LEAS UNDER 37 C.F.R. § 1.132

Mail Stop Amendment

Commissioner for Patents

P.O. Box 1450

Alexandria, Virginia 22313-1450

Sir:

I, **Alain LEAS**, do declare that:

1. I am a citizen of The United States of America and reside at 5927, St. Fillans Court, Dublin, OH 43017
2. I hold a Bachelor Degree in Chemistry from University of Liege (Belgium).
3. I am one of the named inventors in the above-identified application. I presently hold the position of Sr. Research Scientist at Nestec S.A., the assignee of the present application, where I am responsible for New product development activities. I have held this position for 7 years. In particular, I have been specifically involved in research and development of new ice cream coatings products and technologies. My experience includes work on product analysis, physico-chemical characterization, chocolate, confectionery and ice cream products development and factory troubleshooting. I have been actively involved in such type of work for 24 years.
4. I have reviewed and understand the above-identified application, the pending claims thereof, the pending Office Action, U.S. Patent No. 6,235,324 to Luigi Grigoli et al. ("Grigoli"), European Patent Application No. EP 0848910 to Kuehl ("Kuehl"), European

Patent Application No. EP 276333 to Damato ("Damato"), Japanese Publication JP 2000-118590 to Tanaka et al. ("Tanaka"), U.S. Patent No. 5,425,527 to Selbak ("Selbak"), and U.S. Patent No. 2,106,893 to Krein ("Krein"). I am making the following statements as one of ordinary skill in the art in support of the patentability of the pending claims.

5. The above-identified application is directed to a packaged decorated composite frozen confection product. The product includes an open-ended shell with a decorative pattern design forming a smooth surface of the outer wall of the shell, a filling of a frozen confection at least in the interior volume of the shell, and a packaging sleeve for protecting all of the outer surface of the shell. The shell is made of a solid, fat-based composition and has a shell wall that defines an interior volume for holding at least a portion of an ice confection therein. The shell wall has a substantially smooth outer surface. The pattern design includes strings of a first semi-solid confection material that form a mesh of strings and a second confection material of a contrasting color to that of the first confection material located between the strings. The packaging sleeve is formed in a shape that corresponds to the desired shape of the outer surface of the shell and has an inner surface that is in contact with the outer surface of the shell to form and display the pattern. The entire packaging sleeve is partly or entirely transparent, and the entire outer surface of the shell is in complete surface-to-surface contact with the packaging.

6. Grigoli relates to a product in which ice cream is contained inside a chocolate shell, which is then inserted in a wafer. The chocolate shell extends along all the inside surface of the wafer and projects for a certain portion upwardly beyond the wafer. The chocolate shell can be higher than the wafer, extending to the outer surface of the product, which is then finished by applying a decoration and/or a dosage of chopped almonds after its solidification. After manufacture, the product is inserted into a paper cone or envelope.

7. Kuehl discloses a marbled confectionary coating for ice cream. The coating is prepared from a coating material, which may be chocolate, or a water-based material such as creamy mixes, non-aerated ice cream mixes, sorbets, water ices, or fruit purees. Kuehl teaches that coatings in which one layer consists of either milk or plain chocolate and the other layer consists of white chocolate are the most interesting visually because there may be a marked contrast between the milk or plain chocolate and the white chocolate. Kuehl does not disclose a packaging sheet for wrapping the bars, and either places strips of chocolate in a mold

or applies stripes or dots of chocolate upon an ice confection in the shape of a bar. Thus, Kuehl does not teach that a chocolate shell is in complete surface-to-surface contact with a packaging sleeve. Kuehl focuses instead on the provision of different colors or surface contours to provide a visually interesting product during consumption.

8. Damato is directed to a container for receiving an ice cream cone. A lid is fitted for closing the conical opening of the container. The container and the lid consist of a liquid-tight, transparent material to make the package of ice cream visible to the consumer.

9. Tanaka relates to an ice cream container that allows ice cream to be eaten with a spoon as in a cup-shaped container. A cone-shaped container is provided by integrating a cone cup for housing ice cream, a lower cup portion for accommodating the cone cup, and an upper cup portion. The cone cup is made from a wafer.

10. Selbalk discloses a cone-shaped shell of baked cookie dough for holding ice cream or the like. Moisture absorbing particulate ingredients, such as chocolate chips, baking chips, nuts and candy pieces, may be included in the dough.

11. Krein relates to a method of making a frozen confection package wherein ice cream, sherbet, or the like is provided with a chocolate covering and the whole is contained in a temporary wrapper. The method is characterized by the seating of a wrapper in a holder with marginal portions overlapped but ungummed, and a spraying of the chocolate into the wrapper. The chocolate adheres to the inside surface of the wrapper and retains it in its desired form. The confection is frozen in the wrapper after the latter has been sprayed with the chocolate. Krein uses a paper wrapper to enclose its product.

12. Grigoli does not teach or suggest that the packaging sleeve protects all of the outer surface of the shell, or that the entire outer surface of the shell is in complete surface-to-surface contact with the packaging sleeve. Grigoli's chocolate shell is first inserted into the wafer, and then inserted into a paper cone. Therefore, the paper cone does not protect or contact the whole outer surface of the chocolate shell as in the present invention. Nor does he disclose the use of a transparent plastic sleeve to display the shell prior to removal from the package.

13. There is no suggestion or motivation to combine Grigoli with Kuehl.

There is nothing in Grigoli that suggests that a pattern design should be placed on the chocolate shell. By inserting the chocolate shell into the wafer, and by positioning the wafer and upper portion of the chocolate shell in a paper envelope, there would be no advantage in appearance of Grigoli's product, since the consumer would only see the envelope or only a portion of the chocolate shell and a wafer cone and not the inner chocolate shell. Grigoli's chocolate shell is mostly hidden within the wafer.

14. Grigoli's decoration of the cone involves dosing on the upper surface a

certain quantity of chopped almonds or by applying a decoration of liquid chocolate, syrup, or other topping. Grigoli's topping decoration is significantly different and much simpler to achieve than the marbled appearance of Kuehl's bar. One of ordinary skill in the art would not look to Kuehl to further decorate Grigoli's cone. Kuehl teaches attractive coatings for ice cream bars, not chocolate cone-shaped products.

15. The primary purpose of Kuehl is to impart an attractive appearance to its

chocolate bars, rather than impart a more pleasing taste. This is evidenced by Kuehl's emphasis on the different patterns, shapes, or colors of the coatings. The maintenance of a smooth outer surface is not of significance to Kuehl's products. Smoothness is incidental and requires an additional step (i.e., placement of different colored chocolate strips in a mold) to accomplish. Kuehl also does not utilize a sleeve that conforms to the outer surface of the confection. In contrast, the present invention is made in a much less complicated manner, with the strings being provided to conform to and be in contact with a packaging sleeve of similar dimensions during formation of the shell so that a smooth outer surface is automatically achieved during formation of the product.

16. There is no suggestion or motivation to combine Kuehl with Damato.

Damato is concerned with conical ice cream products, not bars. Ice cream bars would not require a separate container and lid, as taught by Damato. Damato also does not appear to teach a chocolate shell, but a wafer cone, which is absent from Kuehl.

17. There is no suggestion or motivation to combine Grigoli with Tanaka.

Grigoli shows that the ice cream filling is contained within the chocolate shell and does not extend above it and onto the paper cone. Modifying Grigoli in view of Tanaka so that the ice

cream extends over the cone and contacts the paper cone would not be ideal. When the ice cream melts, it would flow behind the chocolate layer where it could wet the wafer and make it soggy and unappetizing. The ice cream would also wet the paper cone, making it sticky.

18. There is also no suggestion or motivation to combine Kuehl with Selbalk. Kuehl is concerned with chocolate bars that do not include a cone, while Selbalk relates to cookie dough cones.

19. There is no motivation or suggestion to include a decorative pattern on the surface of the chocolate shell of Krein. Like Grigoli, Krein uses a paper wrapper to enclose its product instead of the partially or entirely transparent packaging sleeve of the present invention. Krein is not interested in the appearance of his product, but is focused on providing an efficient and economic method of making a frozen confection package provided with a chocolate covering and contained in a temporary wrapper. There would be no advantage in including a decorative pattern design on the shell of Krein, since the consumer would only see the wrapper, and not any pattern on the shell.

20. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application, and any patent issuing thereon.

Dated: July 2nd, 1997



Alain LEAS

APPENDIX C – RELATED PROCEEDINGS APPENDIX

None.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Attorney Docket No.: 88265-74701

APPEAL BRIEF FEE TRANSMITTAL

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Commissioner for Patents

P.O. Box 1450

Alexandria, Virginia 22313-1450

Sir:

The fee for submitting the enclosed Appeal Brief of even date herewith is believed to be \$510.00 pursuant to 37 C.F.R. § 41.20(b)2. Please charge all required fees to Winston & Strawn LLP Deposit Account No. 50-1814.

Respectfully submitted,

Date

1/13/09


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